REMARKS

Reconsideration is respectfully requested in view of the remarks made herein.

Claims 1-21 and 23 are pending and stand rejected.

Claims 1, 12, 18 and 21 are independent claims.

Claims 1-20 stand rejected under 35 USC §103(a) as being unpatentable over Miyachi (USPPA no. 2003/0043165) in view of Myers (US Pub. No. 2002/0041288 A1). Claims 21 and 23 stand rejected under 35 USC §103(a) as being unpatentable over Myers in view of Miyachi.

It is respectfully submitted that in order to establish a *prima facie* case of obviousness, three basic criteria must be met;

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)

In KSR Int'l. Co. v. Teleflex, Inc., the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed:

> "Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**." KSR, 82 USPQ2d 1385 at 1396 (emphasis added).

Further, MPEP 2143 states:

> "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."

Claims 1-20 stand rejected under 35 USC §103, applicant respectfully disagrees with and explicitly traverses the rejection of the claims. The independent claims recite that the adjusting of the colors is performed by linearly scaling individual colors based a smallest out-of-gamut color so that the smallest out-of-gamut color is adjusted to a known value within the gamut of colors.

Miyachi discloses a system for adjusting the color of a display device by increasing a gradation level of a color signal having a highest gradation level while decreasing a gradation level of a color signal having the lowest gradation

level when the gradation levels are not equal. Miyachi discloses in paragraph [0071] the adjustment of a color gradation level as a function of the other colors and that negative values are fixed to a zero value. Accordingly, Miyachi discloses a system wherein the colors are adjusted based on predetermined constant factors and the relationships among the colors.

The Final Office Action indicates that the limitation of "smart clipping the corrected image by "adding white" to out-of-gamut digital data of the color image..." is shown in Miyachi in [0071] applicants respectfully disagree. In [0071] Miyachi teaches color conversion of "the gradation values of R, G and B of the inputted color image signal to, r', g' and b' which are the gradation values calculated by the following equations. (Note; when a calculation result is a minus value, it is denoted by 0)." Although the Final Office Action indicates that this is equivalent to adding white, applicants disagree, this is more equivalent to 'clipping' as further described in the present application, page 4, line 24 to page 5, line 23. The present invention does not simply set negative color data values to zero but "adds white" proportional to the out-of-gamut data, see page 6, line 29 – page 7, line 3 and then further scales the other color data. Thus, Miyachi fails to teach the above limitation.

As further indicated by the Office Action, Miyachi fails to disclose a system wherein the color values are linearly adjusted such that the smallest value is set to a known value within the gamut of colors as is recited in the claims.

Myers discloses a system for matching color displayed by source and destination display devices and particularly for providing color matching between a computer monitor and an ink printer.

The Office Action refers to Myers for teaching "adjusting said individual colors of said out-of-gamut digital data by linearly scaling said individual colors based on a smallest value of said digital data individual colors, wherein said adjusted smallest value is set to a known value within said gamut of the color image". However a review of the cited sections ([0029], [0036]) reveals that Myers discloses using *ratio values of the source and destination display devices*, which are scaled and then linearly interpolated over a range, and not "out-of gamut digital data" as claimed. Importantly, the present invention allows for the colors of the input signal that can be represented on the display to be un-affected, but as a result of this correction, colors that cannot be represented are mapped to a color inside the gamut." See page 2, lines 1-13. Instead Myers teaches a color ratio that will cause the destination device to display a color that essentially matches each of fully saturated single and dual colors of a source display device. See Abstract.

Moreover, Myers that teaches setting the white level to the minimum of the RGB color values. See [0036]. The minimum of the RGB color values is clearly not out-of-gamut digital data but an RGB monitor value. Thus, the Myers

does not teach adjusts said individual colors of said out-of-gamut digital data, but adjusts the in-gamut digital data of the color ratios of the devices.

Hence, Myers fails to disclose adjusting said individual colors of said out-of-gamut digital data by linearly scaling said individual colors based on a smallest value of said digital data individual colors, wherein said adjusted smallest value is set to a known value within said gamut of the color image, as is recited in the claims. In addition, Myers fails to disclose the scaling of the colors to a maximum value based on the color with the maximum value.

The Final Office Action indicates it would have been obvious to combine Myer's minimum white value teachings with the color boosting teaching of Miyachi... . However, to simply state that the idea of adjusting said individual colors of said out-of-gamut digital data by linearly scaling said individual colors based on a smallest value of said digital data individual colors, wherein said adjusted smallest value is set to a known value within said gamut of the color image; and scaling said adjusted colors to a maximum value based on a maximum value of one of said adjusted colors..... is obvious based on the above white value and color boosting teachings begs the question, How? It is easy to allege this as being an obvious modification. It is much easier said, however, than done. To allege otherwise is merely to reduce the method of claim 1 to a mere "gist" or "thrust." Such an interpretation disregards the "as a whole" requirement of MPEP 2141.02, and distills the complexities of the actual system of Claim 12 (the

implementation of the method of Claim 1) to an abstract general buzz word, precisely the problem obviated by MPEP 2141.02.

What reference teaches, and moreover provides the motivation to combine, how is the integration to occur, what suggests the desirability of such a combination? Thus, it is not seen how the above list of elements of Miyachi and Myers provides the motivation to combine into the above claimed limitation...without improper hindsight by "use[ing] the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention," see *In Re Denis Rouffet,* 47 USPQ.2d 1453, 1457-58 (Fed. Cir. 1998). The Federal Circuit in *In re Rouffet* stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find many elements of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references and further a motivation to modify the combination to justify a finding of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

The mere fact that the prior art device could be modified so as to produce the claimed device, which in this case even in combination it does not (as discussed herein), is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, In re Gordon, 733 F.2d 900,

902 (Fed, Cir. 1984); and In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989).

The only suggestion that can be found anywhere for making the modification appears to come from the present patent application itself.

Accordingly, applicants respectfully submit that independent claims 1, 12, 18 and 21are allowable.

With regard to the remaining claims, these claims depend from the independent claims 1, 12, 18 and 21 and are thus also allowable by virtue of their dependency upon an allowable base claim.

For the amendments made to the claims and for the remarks made, herein, applicant submits that the reason for the rejection of the claims has been overcome and respectfully requests that the rejection be withdrawn and a Notice of Allowance be issued.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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Date: June 7, 2010

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